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REMARKS

In this application for reissue of U.S. Patent No. 5,971,751, the only new claims are claims 7 and 8, which have been rejected pursuant to 35 U.S.C. § 103(a) over U.S. Patent No. 4,850,854 to Buck ("Buck") in view of U.S. Patent No. 3,984,738 to Mohr ("Mohr"). *See* Office Action dated April 4, 2005. Applicant's previously submitted response on May 11, 2005 to the § 103(a) rejection was deemed unpersuasive. The § 103(a) rejection over Buck and Mohr was then made final. *See* Final Office Action dated December 27, 2006. Applicant respectfully traverses the rejections under § 103 for the following reasons.

I. Remarks on Claim Amendments

The rejection issued under § 103(a) of claims 7 and 8 was over a combination of the Buck and Mohr patents. In brief, Examiner concluded that the piezoelectric unit of the present application provides an upward force in accordance with Mohr, while the "pressure-absorbing device" is a spring that, in accordance with Buck, provides additional upward force as recited in claims 7 and 8.

Buck further discloses a pressure absorbing device (unnumbered spring to the right of pivot 84 in Fig. 3), that is positioned to engage an underside of the thumb push cap to impede movement of the cap and provide an upward force that would additional (*sic*) to any upward force provided by the piezoelectric unit.

See Final Office Action, ¶4. Applicant is in agreement with Examiner that the "unnumbered spring" in Figure 3 of Buck, like spring (312) in Figure 3 of the present application, provides an upward force. However, the "pressure-absorbing device" of claims 7 and 8 is not comprised of just spring (312), but rather, it is a *combination* of a deformable resistance piece (311) and the spring (312).

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As shown in Figures 2 and 3 of the present application, it is the combination of deformable resistance piece (311) and spring (312) that comprise the novel “pressure-absorbing device” of claims 7 and 8. It is defined in the specification that the “pressure absorbing device 31 of the safety apparatus 30 comprises a deformable resistance piece 311 and an elastic element 312 coaxially attached to the deformable resistance piece 311...” See col. 3, lines 56-63. The function of the pressure absorbing device is described in column 2, line 15, of the disclosure to be: “to resist a downwardly pressing force applied by an under age child on the thumb push cap while an adult is capable of pushing down the thumb-push cap easily.” More particularly, the **“deformable resistance piece 311 is compressible through deformation when a predetermined amount of pressure is pressed thereon, so that the deformable resistance piece 311, in fact, provides a resistance effect to the under age children who do not have enough physical strength to compress the deformable resistance piece 311.”** See col. 4, lines 57-62 (emphasis added). Accordingly, the operation of the safety apparatus (30) is described as follows:

By releasing the thumb-push cap 20, the compressed elastic element 312 [spring] will then rebound to regain its original form to upwardly push the thumb-push cap 20 returning from the lower igniting position (as shown in FIG. 4) to its upper normal position (as shown in FIG. 3) instantly. At that moment, the deformed deformable resistance piece 311 will also restore its original cylindrical shape.

See col. 4, line 66 – col. 5, line 8. This description refers to Figure 4, which clearly shows how the energy of the deformable resistance piece (311), in concert with spring (312), exerts an upward force on the cap additional to that of the piezoelectric unit, thereby providing a “resistance effect”.

Thus, in claim 7 it is the combination of deformable resistance piece (311) and spring (312) that comprise the “pressure-absorbing device” to impede the movement of the cap.

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Similarly, in claim 8 it is the combination of piece (311) and spring (312) that comprise the pressure-absorbing device “capable of transmitting an additional upward force to said thumb push cap.” The proposed amendments above merely clarify that the “pressure-absorbing device” (31) in claims 7 and 8 is the particular combination of the resistance piece (311) and spring (312).

II. Remarks on Nonobviousness

The previous rejection of claims 7 and 8 were based on the premise that the “pressure absorbing device” was singularly the spring (312). Since, however, the pressure absorbing device is the combination of the deformable resistance piece (311) and spring (312), Applicant submits that the § 103(a) rejection is without grounds. More especially, Applicant submits that the combination of the resistance piece (311) and spring (312) is nonobvious over Buck in view of Mohr.

A. Buck Does Not Teach or Suggest a Pressure Absorbing Device Comprising the Combination of Deformable Resistance Piece and Spring

One of the basic requirements for establishing a *prima facie* case of obviousness is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2143. Here, Applicant strongly disputes the assertion that Buck teaches a pressure absorbing device comprising the combination of a deformable resistance piece and spring. Examiner asserts that, “Buck further discloses a pressure absorbing device (unnumbered spring to the right of pivot 84 in Fig. 3)...” *See* Final Office Action, ¶4. While it is correct that the unnumbered spring in Buck is positioned to engage an underside of the thumb push cap to impede movement of the cap and to provide an upward

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force in addition to any upward force provided by the piezoelectric unit, there is no deformable resistance piece.

It is the deformable resistance piece, working in concert with the spring, that allows the safety apparatus to work for its intended purpose as described in the specification. In relevant part, the safety apparatus works as follow: the claimed lighter has a thumb-push cap 20 operatively mounted on a piezoelectric unit 105. When the cap 20 is depressed, the cap 20 will downwardly drive and press the piezoelectric unit 105 to generate a striking spark. See col. 2, lines 52-60. The safety apparatus 30, comprising a pressure absorbing device 31 disposed under cap 20, provides “an *additional press resistance* to the thumb-push cap 20, so as to resist the downwardly pressing force applied by an under age child while an adult can push down the thumb-push cap 20 easily.” See Col. 3, lines 41-55 (emphasis added). In particular, the “deformable resistance piece 311 is compressible through deformation when a predetermined amount of pressure is pressed thereon, so that the **deformable resistance piece 311, in fact, provides a resistance effect to the under age children who do not have enough physical strength to compress the deformable resistance piece 311.**” See col. 4, lines 57-62 (emphasis added). In other words, it is the combination of the deformable resistance piece (311) and spring (312), but in particular the piece (311), that provides the proper “resistance effect” that makes the lighter safe for children.

B. No Teaching in Buck for Use of Deformable Resistance Piece and Spring Combination as Child Safety Apparatus

Although the unnumbered spring in Buck may provide incidental resistance, it is certainly neither the purpose nor the function of the unnumbered spring to provide the requisite resistance effect for making the lighter safe for children. Indeed, Examiner notes

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"[t]hough the spring illustrated in Fig. 3 of Buck is not described, this spring functions for the same purpose, for instance, as spring (5) shown in Figure 2. The purpose of this spring (50) is to provide a force acting on a lever of a pivot to return a valve to a closed position...." See Final Office Action, ¶6. If it is to be understood that the unnumbered spring in Buck functions principally as a valve release, then Applicant submits that it would not have been obvious to one of skill in the art to employ the spring, much less the spring and a deformable resistance piece, in the manner claimed here.

Furthermore, there is absolutely no teaching or motivation in Buck to use the unnumbered spring as anything other than a valve release, as recognized by Examiner. Generally, it is axiomatic that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *See MPEP § 2143.01.* "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *See id.*, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." (emphasis in original). Although Applicant recognizes that Examiner does not suggest the combination of different references, the principle is the same: obviousness cannot be established absent some teaching,

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suggestion or incentive in the Buck patent to modify the unnumbered spring as suggested by Examiner. The mere fact that the unnumbered spring in Buck provides incidental resistance is not enough to support the contention that one of skill in the art would have recognized the particular combination of deformable resistance piece and spring as a safety apparatus.

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CONCLUSION

The Examiner is respectfully requested to reconsider his position in view of the remarks made herein. It is believed that this application—and specifically, claims 7 and 8—has been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

If any additional fees are required as a result of this amendment, or any credit needs to be made for overpayment of fees, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 500703.

Respectfully submitted,

TROJAN LAW OFFICES
By

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